

REMARKS

Claims Objections

Examiner's objections to Claims 18 and 24-27 have been corrected in the manner suggested by Examiner.

Section 102 Rejections

Examiner rejected all outstanding claims based on the "Greffrath" paper published in the Journal *Pain* in 2002 that was co-authored by Applicant and Drs. Greffrath, Schwarz, Baumgarner, Vogel, Arendt-Nielsen and Treede. No other prior art reference has been cited by Examiner as disclosing or suggesting the invention as currently claimed. Applicant requests reconsideration based on Applicant Nemenov's attached declaration under 37 CFR 1.131 in which Applicant Nemenov proves that he conceived the invention prior to his 1999 work with his co-authors which was reported in the 2002 Pain paper. As proven by the attached declaration, this 1999 work was actually the second actual reduction to practice of the invention as currently claimed. The first reduction to practice occurred in Saint Petersburg, Russia during the period December 1996 to April 1997.

Applicant has carefully reviewed the claims and he has declared under oath that all outstanding claims claim concepts conceived by Applicant Nemenov prior to his collaboration with the above co-authors. Applicant Nemenov has cancelled Claim 23 which was the single claim that arose from his subsequent collaboration with Dr. Yeomans in 2002 and 2003. As stated above a request under 37 CFR 1.48(b) for correction of inventorship, and the statement required by Section 1.48(b) are attached. Applicant has cancelled Claims 32 – 34 because they were duplications of Claim 24.

Conclusion

The only basis for claim rejection provided by Examiner is that the Applicants have not previously provided adequate data to remove the 2002 Pain paper as prior art. Applicant Nemenov through his attached declaration has shown facts in sufficient character and weight to establish conception and the required due diligence prior to any collaboration with the above co-authors. These facts also establish that the invention had been actually reduced to practice prior to the collaboration and that the collaboration was only a second "formal" reduction to practice with sufficient formality to permit publication in an important medical journal. Applicant Nemenov therefore submits that the outstanding claims (namely Claims 12 -15, Claims 17 – 22 and Claims 24 – 31) should now all be allowable and respectfully request that they be allowed and the application allowed to issue as a patent.

Respectfully submitted,



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